REMARKS

Claims 1-31 remain pending in the present application. Claims 1-31 are rejected. Claim 23 has been amended herein. No new matter has been added.

Claim Rejections - 35 U.S.C. §112

Claims 1-31

The present office action states that Claims 1-31 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the presence of "Macintosh Operating System" is not proper.

Applicants respectfully submit section 2173.05(u) of the MPEP states, "The presence of a trademark or trade name in a claim **is not**, per se, improper under 35 U.S.C. 112, second paragraph" (emphasis added).

Further, Applicants respectfully submit section 608.01(v)(I), second paragraph second sentence, of the MPEP states, "If the trademark has a fixed and definite meaning, it constitutes **sufficient identification** unless some physical or chemical characteristic of the article or material is involved in the invention." (Emphasis Added)

Moreover, Applicants respectfully submit they have provided numerous responses to the Office Actions including evidence that the presence of "Macintosh Operating System" in the Claim has a definite and fixed meaning, as well as numerous uses of "Macintosh Operating System" verbage by others, as well as Applicants inability to come up with a more generic name for the "Macintosh Operating system". Further, on page 8 at item 15, the present Office Action also utilizes the **same terms** to define Operating Systems, "Windows operating systems, Mac operating systems and Linux operating systems were the **predominate types of Operating systems**." (Emphasis Added)

However, instead of receiving any type of appropriate guidance, suggestion, or logical reasoning for maintaining the inappropriate rejection, Applicants have received little more than argumentative and pithy unsupported comments.

For example, at page 4 item 9, the present Office Action states "Merely because prior issued patents claim certain features or limitations does not establish the practice as a correct one. For example, there are thousands of patented claims defining digital signals, none of which today are considered valid claims." (Emphasis Added)

Applicants respectfully submit the above cited comment does nothing to promote prosecution of the Application but instead, merely provide unneeded and unnecessary confusion, argument and conflict.

In contrast, Applicants provided the previous responsive comment about numerous Patents and Patent Applications having the term "Macintosh Operating Sytem" therein with a statement that the Applicants did not know of a better or more generic term. Moreover, the statements were provided in an attempt by Applicants to demonstrate that they were not the only Applicants that did not know of a better or more generic term.

At MPEP 706.03(d)

¶ *7.35.01 Trademark or Trade Name as a Limitation in the Claim*

Claim **[1]** contains the trademark/trade name **[2]**. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe **[3]** and, accordingly, the identification/description is indefinite.

Examiner Note:

1.In bracket 2, insert the trademark/trade name and where it is used in the claim.

2.In bracket 3, specify the material or product which is identified or described in the claim by the trademark/trade name.

Applicants would be happy to hear from the Office Action what the Office Action would suggest to be placed in **[3]** as stated above. However, until the Office Action has an idea of what would be more generic, Applicants respectfully submit that to the best of their ability, and with no desire for argument or justification, the term "Macintosh Operating System" is the best, most generic, most established, most fixed in meaning and most descriptive term available.

For these reasons, Applicants respectfully request the rejection of Claims 1-31 under 35 U.S.C. § 112, second paragraph, based on the presence of the trademark "Macintosh Operating System" be withdrawn or another term, be provide in the follow-on Office Action as sufficient identification of the operating system characteristics of the "Macintosh Operating System".

Claim 23

The present office action states that Claim 23 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Moreover, the Office Action has provided a recommendation that "claim 23 be revised back to the version of the claim as listed in the 10/3/08 amendment to overcome this 112 rejection."

Applicants have amended Claim 23 back to the version listed in the 10/3/08 amendment. Thus, for the rationale provided in the present Office Action, Applicants respectfully contend the rejection under 35 U.S.C. §112 is overcome.

Claim Rejections - 35 U.S.C. §103(a)

Claims 1-3, 6-7, and 9-11

Claims 1-3, 6-7, and 9-11 are rejected under 35 U.S.C. §103(a) as being unpatentable over Doherty et al. (US 6,920,567), hereinafter "Doherty". Applicants have reviewed the cited reference and respectfully submit that the embodiments of the present

invention as recited in Claims 1-3, 6-7, and 9-11 are not anticipated by Doherty for the following reasons.

Applicants respectfully submit that Independent Claim 1 includes the feature "utilizing said compliance mechanism to control an output of said media content by said multimedia component, said compliance mechanism diverting a commonly used data pathway output of said media component to a controlled data output pathway monitored by said compliance mechanism after said multimedia component begins to present said contents of said media content, said compliance mechanism utilized to stop or disrupt the playing of said media content at said controlled data output pathway when said playing of said media content is outside of a usage restriction applicable to said media file." (emphasis added)

Support for the Claimed features can be found throughout the Figures and Specification including at least page 30 lines 5-15 and Figures 3 and 5A-5D.

Applicants have reviewed Doherty et al. and do not understand Doherty et al. to teach or render obvious the Claimed feature "utilizing said compliance mechanism to control an output of said media content by said multimedia component, said compliance mechanism diverting a commonly used data pathway output of said media component to a controlled data output pathway monitored by said compliance mechanism after said multimedia component begins to present said contents of said media content, said compliance mechanism utilized to stop or disrupt the playing of said media content at said controlled data output pathway when said playing of said media content is outside of a usage restriction applicable to said media file." (emphasis added)

For this reason, Applicants respectfully submit that Claim 1 is not taught or rendered obvious over Doherty, and as such, the rejection under 35 U.S.C. §103(a) is overcome and Claim 1 is allowable.

With respect to Claims 2-3, 6-7, and 9-11, Applicants respectfully submit that Claims 2-3, 6-7, and 9-11 depend from the allowable Claim 1 and recite further features of the present claimed invention. Therefore, Applicants respectfully state that Claims 2-3, 6-7, and 9-11 are allowable as pending from an allowable base Claim.

Claims 4, 5, 8 and 12-31

Claims 4, 5, 8 and 12-31 are rejected under 35 U.S.C. §103(a) as being unpatentable over Doherty in view of Schreiber et al. (US 6,298,446), hereinafter "Schreiber". With respect to Claims 4, 5, 8 and 12-31, Applicants respectfully assert that Doherty and Schreiber, alone or in combination, fail to teach or suggest the claimed subject matter.

Applicants respectfully submit that Independent Claim 1 (and similarly Claims 12 and 23) includes the feature "utilizing said compliance mechanism to control an output of said media content by said multimedia component, said compliance mechanism diverting a commonly used data pathway output of said media component to a controlled data output pathway monitored by said compliance mechanism after said multimedia component begins to present said contents of said media content, said compliance mechanism utilized to stop or disrupt the playing of said media content at said controlled data output pathway when said playing of said media content is outside of a usage restriction applicable to said media file." (emphasis added)

Support for the Claimed features can be found throughout the Figures and Specification including at least page 30 lines 5-15 and Figures 3 and 5A-5D.

Applicants have reviewed Doherty et al. alone and in combination with Schreiber and do not understand Doherty et al. alone or in combination with Schreiber to teach or render obvious the Claimed feature "utilizing said compliance mechanism to control an output of said media content by said multimedia component, said compliance mechanism diverting a commonly used data pathway output of said media component to a controlled data output pathway monitored by said compliance mechanism after said multimedia

component begins to present said contents of said media content, said compliance mechanism utilized to stop or disrupt the playing of said media content at said controlled data output pathway when said playing of said media content is outside of a usage restriction applicable to said media file." (emphasis added)

As such, Applicants respectfully submit that Doherty et al. alone or in combination with Schreiber fails to teach or render obvious the features of Claims 1, 12 and 23. As such, Applicants respectfully submit Claims 1, 12 and 23 are allowable.

With respect to Claims 4-5, 8, 13-22 and 24-31, Applicants respectfully submit that Claims 4-5, 8, 13-22 and 24-31 depend from the allowable Claims 1, 12 and 23 and recite further features of the present claimed invention. Therefore, Applicants respectfully state that Claims 4-5, 8, 13-22 and 24-31 are allowable as pending from allowable base Claims.

Claims 1-7 and 19-31

Claims 1-7 and 19-31 are rejected under 35 U.S.C. §103(a) as being unpatentable over Doherty in view of Pastorelli (US 2004/0133801), hereinafter "Pastorelli". With respect to Claims 1-7 and 19-31, Applicants respectfully assert that Doherty and Pastorelli, alone or in combination, fail to teach or suggest the claimed subject matter.

Applicants respectfully submit that Independent Claim 1 (and similarly Claims 12 and 23) includes the feature "utilizing said compliance mechanism to control an output of said media content by said multimedia component, said compliance mechanism diverting a commonly used data pathway output of said media component to a controlled data output pathway monitored by said compliance mechanism after said multimedia component begins to present said contents of said media content, said compliance mechanism utilized to stop or disrupt the playing of said media content at said controlled data output pathway when said playing of said media content is outside of a usage restriction applicable to said media file." (emphasis added)

Support for the Claimed features can be found throughout the Figures and Specification including at least page 30 lines 5-15 and Figures 3 and 5A-5D.

Applicants have reviewed Doherty et al. alone and in combination with Pastorelli and do not understand Doherty et al. alone or in combination with Pastorelli to teach or render obvious the Claimed feature "utilizing said compliance mechanism to control an output of said media content by said multimedia component, said compliance mechanism diverting a commonly used data pathway output of said media component to a controlled data output pathway monitored by said compliance mechanism after said multimedia component begins to present said contents of said media content, said compliance mechanism utilized to stop or disrupt the playing of said media content at said controlled data output pathway when said playing of said media content is outside of a usage restriction applicable to said media file." (emphasis added)

As such, Applicants respectfully submit that Doherty alone or in combination with Pastorelli fails to teach or render obvious the features of Claims 1, 12 and 23. As such, Applicants respectfully submit Claims 1, 12 and 23 are allowable.

With respect to Claims 2-7, 19-22 and 24-31, Applicants respectfully submit that Claims 2-7, 19-22 and 24-31 depend from the allowable Claims 1, 12 and 23 and recite further features of the present claimed invention. Therefore, Applicants respectfully state that Claims 2-7, 19-22 and 24-31 are allowable as pending from allowable base Claims.

CONCLUSION

Based on the amendments provided herein and the arguments presented above, Applicants respectfully assert that Claims 1-31 overcome the rejections of record, and therefore, Applicants respectfully solicit allowance of these Claims.

The Examiner is invited to contact Applicants' undersigned representative if the Examiner believes such action would expedite resolution of the present Application.

Respectfully submitted,
WAGNER BLECHER LLP

DATE: NOVEMBER 6, 2009

/JOHN P. WAGNER, JR./

JOHN P. WAGNER, JR.
REG. NO. 35,398

WESTRIDGE BUSINESS PARK
123 WESTRIDGE DRIVE
WATSONVILLE, CALIFORNIA 95076
(408) 377-0500